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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January

17, 2007, has been entered.

Response to Amendment

Applicant's amendments and remarks dated January 17, 2007, were filed in

response to the office action mailed October 18, 2006. Claims 1, 5, 8, 10, 13-14, 17,

and 19-21 are amended. Claims 16, 18, and 22-25 have been cancelled. Claim 7 has

not been provided with the proper status identifier however the examiner is able to

overlook the non-compliance in this case. The origin of the error is clear because claim

7 mirrors claim 17. Applicant likely intended to cancel claim 6 and make claim 7 depend

from claim 1, as claim 16 has been cancelled and claim 17 has been amended to

depend from claim 10. In any case, claims 6,7, and 17 are all rejected under 35 USC §

112, paragraph 2 for the reasons indicated below.

Claims 1-15, 17, and 19-21 are currently pending and considered in this office

action.

Response to Arguments

Applicant's arguments filed January 17, 2007, have been fully considered but they are not persuasive. Applicant's remarks allege that Herz does not teach or suggest three data sets, each generated by a specific network device. Basically that it does not teach or suggest a first data set that is specifically generated by a DVR, a second data set specifically generated by a personal computer, and a third data set specifically generated by a store computer. The claims also extend the steps to cover a fourth data set generated using similar attributes from the first three, rather than the originally claimed third data set generated using attributes from the first two. Several problems arise from these amendments and the supporting remarks. The first two immediate problems are that a fourth data set is not disclosed by the original specification, and that the specification also states that "the use of the terms first, second, etc. do not denote any order or importance, but rather... are used to distinguish one element from another." The later problem does not help mitigate the "fourth" problem because only three elements are enumerated. At the same time it runs counter to the effort to narrow the claim by attributing specific sets to specific devices in a series of steps. Nonetheless, the number of total sets used to generate the final set is ultimately not at issue as it would not be distinguishing from the prior art in this case. It is clear throughout the prior art that a new set is created upon the occurrence of any number of events during which the user expresses a preference, chooses a product, etc.... There is no limit to the number that could be created. Whatever the total number

of sets, they are all then used in generating the final set based on similar attributes of the previous sets.

It is also clear that the prior art sets are generated by a range of devices including digital video, personal computers, store kiosks, and various other computer devices. It is the examiner's understanding therefore that applicant's amendment intends to limit the invention to three data sets generated, specifically, one by a DVR, another by a personal computer, and a third by a store computer, and that these sets are used to generate a fourth set. Applicant asserts that this narrow focus avoids the prior art. It is the examiner's position that the prior art easily and completely encompasses the narrower focus. The prior art sets are generated by devices including digital video, personal computers, store kiosks, and various other computer devices. These devices are interchangeable in the overall prior art system. In other words, the prior art would include a system where three data sets are generated by the three specified devices. It is not however specifically confined to a single such embodiment.

Claim Objections

Claim 1 is objected to because of the following informalities: "determining when the entity selects a second service or product;" appears twice, in line 9 and line 15. The second appearance is out of sequence and appears to be an error, where "second" should be "third." Appropriate correction is required.

Claims 6,7, and 17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s)

in proper dependent form, or rewrite the claim(s) in independent form. The claims are

defective because:

- claim 6 depends from claim 1 and states, "a first network device generates the

    first data set." Claim 1 specifies, "the first data set is generated by a digital video

    recording (DVR) device...." This renders claim 6 defective.

- claim 7 depends from claim 6 and states, "a second network device generates

    the second data set, the second data set is generated by a cell phone...." Claim

    6 in turn depends from claim 1, and claim 1 specifies, "the second data set is

    generated by a personal computer...." This renders claim 7 defective.

- claim 17 depends from claim 10 and states, "the second device comprises a

    second network device, the second device is a cell phone...." Claim 10 specifies,

    "the second device is a personal computer...." This renders claim 17 defective.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

1.   **Claims 1-15, 17, and 19-21 are rejected under 35 U.S.C. 112, first paragraph,**

as failing to comply with the written description requirement. The claim(s)

contains subject matter that was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

The specification describes a third data set generated based on similar first and

second attributes from first and second data sets. It does not describe a fourth data set.

The claims now are directed to a third data set that is not derived from similar first and

second attributes from first and second data sets, but is derived in a manner similar to

that originally practiced by only the first and second data sets. The claims are also now

directed to a fourth data set that is generated in a manner similar to that only disclosed

in the specification as being practiced by the third data set.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   **Claims 1-15, 17, and 19-21 are rejected under 35 U.S.C. 112, second**

paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention.

The term "separate" in claims 1,10, and 21 is a relative term that renders the

claim indefinite. The term "separate" is not defined by the claim, the specification does

not provide a standard for ascertaining the requisite degree, and one of ordinary skill in

the art would not be reasonably appraised of the scope of the invention. The term

appears in the phrase "personal computer separate from the (DVR) device." Perhaps

this is intended to mean that the personal computer is not also the (DVR) device. There

could very well be two different devices that are both capable of recording digital video

and the personal computer could be one of them. Putting that aside, however, the term

"separate" could mean many things. Does it mean that they are in different locations, or

merely that they are two different devices? Does it mean that they are not connected by

any means, or that they do not communicate directly with each other but are in fact

connected through the network? Does it mean that they are directly connected through

a communication link but are physically separated by some distance?

The term "substantially similar" in claims 1,10, and 21 is also a relative term that

renders the claim indefinite. The term "substantially similar" is not defined by the claim,

the specification does not provide a standard for ascertaining the requisite degree, and

one of ordinary skill in the art would not be reasonably appraised of the scope of the

invention. The specification does give some guidance as to the intended meaning of

the phrase, however, the degree of similarity required for the attribute to become

"substantially similar" cannot be ascertained.

Claims 1 and 5 recite the limitations "the third service or product" in line 16, and

"the textual data of the ... third attribute" in line 4, respectively. There is insufficient

antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-6, 9-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Herz (Paper # 060324; US Patent No. 6,029,195) in view of

Official Notice (regarding common sense design choice).

Herz teaches a system for comparing attributes of multiple data sets to determine

similarities and then create new data sets based on the similarities. Herz further

teaches:

- determining when the entity selects a first service or product: generating a first

  data set having a first attribute associated with the first service or product (see at

  least abstract, fig.10); wherein the first data set is generated by a digital video

  recording device and includes a unique identifier associated with an entity, a

  date, a time and a title of a program or movie selected by the entity for recording

  on the digital video recording device (see at least abstract, column 32 line 65-

  column 33 line 59, column 43 line 53-column 44 line 49, column 39 line 57 –

  column 40 line 33. Please note: passages show that electronic media includes

  video and that video recording devices are among the potential devices that

  generate profile data. Please note: The particular information included in the

  data set is descriptive material and is not functionally involved in the recited steps

  of the method. Because it has no functional role in the method it is non-

  functional descriptive material. This descriptive material will not distinguish the

  claimed invention from the prior art in terms of patentability, see In re Gulack,

  703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); first

  device configured to determine whether the entity purchases, submits an order

for the first service or product (see at least column 5 lines 36-45, column 18 line

40-column 19 line 7, column 68 lines 5-10, column 77 lines 17-47); a first network

device generates the first data set (see at least abstract, fig.1,2); a first device

configured to determine when the entity selects a first service or product and

generating a first data set having a first attribute associated with the first service

or product (see at least abstract, fig.1,2,10,12); first device comprises one of a

computer, a cellular phone, or a digital video recording device (see at least

fig.1,2).

- <u>determining when the entity selects a second service or product</u>: generating a

  second data set having a second attribute associated with the second service or

  product (see at least abstract); wherein the second data set is generated by a

  personal computer separate from the (DVR) device, the second data set

  including a unique identifier associated with an entity, a data, a time, and a web

  address accessed by the personal computer (see at least abstract, figs.1,2;

  column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65-

  column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 –

  column 73 line 42); a second device configured to determine when the entity

  selects a second service or product and generating a second data set having a

  second attribute associated with the second service or product (see at least

  abstract, fig.1,2,10);

- <u>generating a data set based on the first and second attributes</u>: when a portion of

  data associated with the first attribute is substantially similar to a portion of data

associated with the second attribute (see at least abstract, column 5 lines 6-20,

column 26 lines 2-21); a third network device generates the third data set (see at

least abstract, figs.1,2); a third device configured to generate a third data set

based on the first and second attributes when a portion of data associated with

the first attribute is substantially similar to a portion of data associated with the

second attribute (see at least abstract, figs.1,2,10; column 5 lines 6-20, column

26 lines 2-21); third device is operably associated with a grid computer network

(see at least abstract, figs.1,2); third device comprises a computer server

communicating with the first and second devices (see at least figs.1,2);

associating at least a first attribute of the first historic data set with at least a

second attribute of the second historic data set, the first attribute being

substantially similar to the second attribute and generating a third dynamic data

set based on at least one of the first and second attributes of the first and second

historic data sets (see at least abstract, figs.1,2,10; column 5 lines 6-20, column

26 lines 2-21).

- the data associated with the first attribute comprises textual data: and the data

  associated with the second attribute comprises textual data (see at least

  abstract, column 5 lines 6-20, column 9 lines 19-30, column 77 lines 17-47);

  generating the third data set based on the first and second attributes includes

  determining whether at least a portion of the textual data of the first attribute is

  identical to at least a portion of the textual data of the second attribute and

  forming the third data set having a third attribute containing at least a portion of

textual data from one of the first and second attributes (see at least abstract,

column 5 lines 6-20, column 77 lines 17-47).

• <u>entity comprises one of a person or a group of people</u>: (see at least abstract,

column 9 lines 31-42. Please note: the identity of the entity has no functional role

in the method and a person or group of people are themselves not patentable

subject matter.).

• <u>A storage medium encoded with machine-readable computer program code for

generating data sets associated with an entity</u>: (see at least column 9 lines 19-

30).

• <u>generating a plurality of historic data sets by monitoring activities of a legal entity</u>:

(see at least fig.10, column 77 lines 17-47); identifying a plurality of attributes

contained in the plurality of historic data sets (see at least figs.5,10, column 77

lines 17-47); determining a plurality of values wherein each value is associated

with one attribute of the plurality of attributes and corresponds to a number of

historic data sets of the plurality of historic data sets containing the one attribute

(see at least fig.12); determining a plurality of dynamic data sets containing the

attributes wherein the plurality of dynamic data sets are ranked based on the

plurality of values (see at least abstract, fig.12, column 18 line 40-column 19 line

7, column 19 line 29-column 20 line 22, column 77 lines 48-67); iteratively

generating the plurality of historic data sets by monitoring activities of the legal

entity (see at least abstract, figs.5,10; column 20 line 47-column 21 line 4).

Herz teaches all the above as noted and teaches a) continuously generating any number of data sets, b) storing any number of data sets, c) comparing large numbers of data sets, d) analyzing large numbers of data sets to determine similar attributes among the data sets, e) generating new dynamic data sets based on the similarities in previously generated data sets, f) generation of data sets from various network devices, and g) generating data sets from network devices including digital recording devices, personal computers, store computers (kiosks, or merely any computer whose user happens to be affiliated with a store as a shopper or employee). Herz does not however explicitly disclose a situation explicitly limited to only three data sets generated by devices in which one device must be a digital video recording device, another must be a personal computer, and a third must be a store computer, with a data set that is explicitly limited to being the fourth data set and that is generated from the similar attributes of the previous three data sets. The examiner takes the position that it would have been an obvious matter of design choice to limit the invention to only three data sets generated by devices in which one device must be a digital video recording device, another must be a personal computer, and a third must be a store computer, with a data set that is explicitly limited to being the fourth data set and that is generated from the similar attributes of the previous three data sets, since applicant has not disclosed that this arrangement solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any similar arrangement. The arrangement to which the invention is confined could easily occur in the prior art by mere coincidence. Therefore it would have been obvious to one of ordinary skill in the

art at the time of the invention to choose the presently disclosed arrangement for the

system of Herz as taught by Official Notice, as it would be the natural consequence of

using the system in environments were only the three stated devices are in use, thereby

increasing commerce using the system.

Pertaining to method claims 1-6 and 9

Rejection of claims 1-6 and 9 is based on the same rationale as noted above.

Pertaining to encoded storage medium claim 21

Rejection of claim 21 is based on the same rationale as noted above.

**4.   Claims 7-8 and 17 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Herz (Paper # 060324; US Patent No. 6,029,195) and Official
Notice (regarding common sense design choice), and further in view of
Lammerhuber (Paper # 20061011; US Pub. No. 2003/0079219).**

Herz and Official Notice teach all of the above as noted and teach a) a unique

user identification, b) generating datasets of attributes of products or services, c)

associating user identification with datasets, and d) determining the interest of the user

in the products or services. Herz and Official Notice do not however disclose a data set

generated by a cell phone equipped with a barcode scanner, including a universal

product code from a barcode scanned by the barcode scanner, the universal product

code corresponding to second service or product. Lammerhuber teaches a) a unique

user identification, b) generating datasets of attributes of products or services, c)

associating user identification with datasets, d) determining the interest of the user in

the products or services, and also teaches a data set generated by a cell phone

equipped with a barcode scanner, including a universal product code from a barcode

scanned by the barcode scanner, the universal product code corresponding to a second

service or product (see at least abstract, fig.1, page 1 paras.0004-0009). Therefore it

would have been obvious to one of ordinary skill in the art at the time of the invention to

modify the system of Herz and Official Notice to include a data set generated by a cell

phone equipped with a barcode scanner, including a universal product code from a

barcode scanned by the barcode scanner, the universal product code corresponding to

a second service or product as taught by Lammerhuber, in order to increase the range

of commercial environments in which the system is useful, thereby increasing

commerce using the system.

Pertaining to method claims 7-8

Rejection of claims 7-8 is based on the same rationale as noted above.

Examiner cites particular columns and line numbers in the reference as applied

to the claims above for the convenience of the applicant. Although the specified

citations are representative of the teachings in the art and are applied to the specific

limitations within claims, other passages and figures may apply as well. It is respectfully

requested that, in preparing responses, the applicant fully consider the reference in

entirety as potentially teaching all or part of the claimed invention, as well as the context

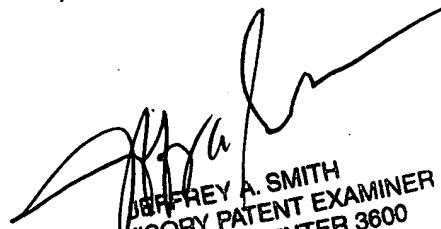of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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February 2, 2007

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